

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

The sole issue for consideration is the rejection of claims 1-5 under 35 USC § 103(a) as being obvious over Hoffmann, US 5,562,789, in view of Treleaven, US 6,413,345. In response, Applicants again respectfully request that the Examiner reconsider and withdraw this rejection.

The rejected claims all relate to a method comprising diecutting a web having adhesive applied thereto along a diecutting line that is required to be “a non-branching line having a form other than that of a straight line.” In the middle of page 2 of the Office Action dated March 9, 2006, the Examiner conceded that Hoffmann “does not disclose the die cut line configuration as claimed by the applicant.” However, the Examiner found this gap between the instant claims and Hoffmann was bridged by Treleaven, which, according to the Examiner, shows the tear lines with a saw-toothed configuration. According to the Examiner:

“It would have been obvious to one having ordinary skill in the art to employ a saw-toothed tear line, as taught by Treleaven, in the method of Hoffmann *as a matter of design choice* based on desired physical properties and appearance of the label being produced.”

In other words, the Examiner did not identify any *practical* expected advantages of making the substitution, but, rather, only differences in design choice leading to different (unspecified) physical properties and appearance.

In response, on pages 4-5 of the amendment dated June 9, 2006, Applicants explained to the Examiner why the present claims were characterized by unexpected results attributable to the

use of a non-branching diecutting line other than a straight line. To repeat, Applicants explained as follows:

“Applicants would call the attention of the Examiner to the Example, which begins on page 23 of the specification. **The Examiner’s attention is especially directed to the discussion at page 25, lines 10-30.** Simply put, the requirement of the instant claims that the diecutting line is a non-branching line having a form other than that of a straight line is much more than a simple design choice. The use of the inventive form has the surprising effect of *increasing the speed* with which the diecuts can be applied. As taught at page 25, lines 10-12, straight-line diecuts can be dispensed from a device at a maximum rate of **0.3 m/s**. In contrast, as taught at page 25, lines 13-15, a corresponding undular diecut can be dispensed from the same device at a much higher maximum rate of **2.0 m/s**. Speed of application is, of course, an important parameter in practice. Accordingly, the difference shown is of great practical effect. There is absolutely nothing in the combination of Hoffmann and Treleaven that teaches or suggests that use of an undular diecut form as opposed to a straight-line diecut form should increase the speed of application of the diecuts. Yet, this is exactly what the data in the instant specification prove happens. Further, the explanation at page 25, lines 16-30, provides a reasonable basis for concluding that the data are representative of the full breadth of the claims. Indeed, the specification teaches at page 25, lines 16-18, that “[t]he comparison shows that ‘non-straight’ cross-diecutting forms permit a faster application of the diecuts in contrast to a straight form of the diecutting line.” Again, the combination of Hoffmann and Treleaven is completely silent as to such a benefit. Accordingly, the data in the specification must be considered to be surprising,

and, thus, unexpected, and, therefore, as objective evidence of the nonobviousness of the instant claims. Although these data are not in declaration form, consistent with the rule that *all* evidence of nonobviousness must be considered when assessing patentability, the Examiner must consider data in the specification in determining whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995)."

In the first full paragraph on page 4 of the final rejection dated August 23, 2006, the Examiner conceded that unexpected results had been shown, but commented that Applicants' claims did not recite any diecutting speed and, therefore, the unexpected results were irrelevant to the claims.

In response, Applicants argued in the amendment dated November 22, 2006, that the unexpected results were, in fact, relevant to the instant claims as the feature responsible for the unexpected results, i.e., the non-branching diecutting line other than a straight line, was a requirement of the rejected claims.

The Examiner now makes new points in the latest Office Action, which new points will be dealt with below. However, the following is established: 1) The Examiner theorizes that a person having ordinary skill in the art would have found it *prima facie* obvious to use a non-branching diecutting line other than a straight line purely as a matter of design choice, not expecting that design choice to have any practical significance; 2) Applicants have demonstrated that the use of a non-branching diecutting line other than a straight line unexpectedly has practical significance, i.e., such use permits a faster application of the diecuts than diecuts made with a straight diecutting line; and 3) the instant claims require the use of the non-branching diecutting line other than a straight line for which unexpected results have been demonstrated.

Applicants respectfully submit that this ends the matter, and that the Examiner would be fully justified to reconsider and withdraw this rejection.

Taking the Examiner's various points, the Examiner says in the middle of page 3 of the outstanding Office Action that Applicants' claims are directed to a method, not a product, and do not in any case recite any improved properties, and, therefore, Applicants' arguments are irrelevant. In response, Applicants point out that the difference between the Hoffmann reference and the claims is alleged by the Examiner to be the use of a non-branching line other than a straight line, which the Examiner says is rendered obvious by Treleaven, which teaches the use of such a line is a matter of design choice. However, the instant claims, as noted above, require the use of a non-branching diecutting line other than a straight line. As the data in the instant specification clearly shows, the use of such a line is not merely a matter of design choice, as the Examiner alleged, but gives rise to unexpected results, namely a faster application speed of the diecuts. Thus, the claims do, in fact, recite the features that, if carried out, result in improved properties. In other words, the improved properties are inherent to the method as claimed and, therefore, must be considered.

Towards the bottom of that same page, the Examiner says "*if* the prior art dispensed *undular* diecuts at a slower rate of 0.1 m/s, it would meet the limitations of applicant's claims because it shows all of the steps recited in the claims." In response, Applicants submit such theorizing is irrelevant to the obviousness determination. Moreover, Applicants point out that the prior art doesn't show either undular diecuts or application at a slower speed, and, accordingly, such hypotheticals, like the *prima facie* case itself, do not stand in the way of the grant of the instant claims. The Examiner's *prima facie* case is not the prior art. It is only the Examiner's theory why one skilled in the art, given the prior art, might have been led to the

present invention. Importantly, it is rebuttable by proofs showing the Examiner's theory is wrong. According to the Examiner, the difference between a straight-line diecut and a non-branching line other than a straight-line is trivial, being merely a matter of an obvious design choice resulting in different physical properties or different appearance. Applicants countered that the Examiner's theory was incorrect: The use of a non-branching line other than a straight-line is of practical importance, leading to increased diecut application speeds. This was backed up by data in the specification proving exactly this improvement by proceeding with the presently claimed method. Respectfully, this rebuts the Examiner's hypotheticals and proves nonobviousness.

Finally, at the top of page 4, the Examiner cites to *Ex parte Obiaya*. However, that case is clearly distinguishable from the instant case. In *Obiaya*, the use of the claimed labyrinth heater was urged to have been obvious because it maintained samples at a uniform temperature, i.e., a practical benefit. This is quite different from the instant case, where the Examiner says the prior art teaches a non-branching line other than a straight line as a matter of design choice. Whereas here, where the Examiner alleges the claimed invention would have been obvious as a routine matter of design choice substitution, Applicants' showing that the substitution has important practical implications that are, moreover, unexpected, results the notion that the substitution would have been *prima facie* obvious.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance.

However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
NORRIS MC LAUGHLIN & MARCUS, P.A.

By /Kurt G. Briscoe/

Kurt G. Briscoe
Attorney for Applicant(s)
Reg. No. 33,141
875 Third Avenue - 18th Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844